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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,599	09/21/2001	Steven M. Geiger	213828013US2	6626

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EXAMINER

FRIDIE JR, WILLMON

ART UNIT	PAPER NUMBER
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3722

12

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EE

Office Action Summary

Application No.

09/960,599

Applicant(s)

GEIGER ET AL.

Examiner

Willmon Fridie, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 15-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 2-9, 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 2,3,5-9,15,16,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO ('217) in view of Hoffman.

EPO ('217) discloses a coin discriminator having a discriminator printer and inherently discloses the claimed method except for the teaching of placing visible security marks on the voucher that have security properties. Hoffman teaches that it is well known in the art to place visible security marks on a substrate that have security properties such that they have a second appearance when they are photocopied. It would have been obvious to one having ordinary skill

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in the art at the time the invention was made to provide EPO('217) with visible security marks on its voucher that have security properties such that they have a second appearance when they are photocopied in the manner as taught by Hoffman in order to add an extra measure of security to the financial transaction.

In regard to claims 5 and 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use florescent ink, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regard to claims 7-9,15,16,18 and 19, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the indicia in any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Further in regard to claims 7-9,15,16,18 and 19, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the

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substrate for the printed matter is not the kind of functional relationship necessary for patentability.

4. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO ('217) in view of Hoffman as applied to claims 2,3,5-9,15,16,18 and 19 above, and further in view of Puckett et al. .

EPO ('217) as modified by Hoffman discloses the claimed invention except for a voucher formed of thermal paper Puckett et al. teaches that it is well known in the art to use thermal paper for vouchers, receipts, etc.. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide EPO ('217) as modified by Hoffman with thermal paper in the manner as taught by Puckett et al in order to increase the versatility of the printing process.

In regard to claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

Allowable Subject Matter

5. Claim 21 is allowed.

Response to Arguments

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, Hoffman discloses "a second appearance different from said first appearance" defined by the mis-alignment of the indicia after photocopying. This misalignment clearly constitutes a "a second appearance different from said first appearance". Also a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In regard to applicants arguments concerning the use of fluorescent ink, both references disclose the use of printers with ink, hence the use of florescent ink would have been obvious to one having ordinary skill in the art at the time the invention was made use since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice

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In response to applicant's arguments regarding claims 7 and 8, the location of the indicia would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the indicia in any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art and since applicant has not disclosed that these features solves any stated problem or is for any particular purpose and it appears the invention would perform equally well with regardless of the location of the indicia.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willmon Fridie, Jr. whose telephone number is 703 308 1866. The examiner can normally be reached on M-F (8:30am-6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on 703 308 2159. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703 872 9306 for regular communications and 703 872 9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.



Willmon Fridie, Jr.
Primary Examiner
Art Unit 3722

wf
July 27, 2003